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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,821	10/06/2003	Mitsuro Unno	A42023	3402
25946	7590	10/25/2005	EXAMINER	
TEXAS INSTRUMENTS INCORPORATED 34 FOREST STREET, MS 20-21 ATTLEBORO, MA 02703			VORTMAN, ANATOLY	
			ART UNIT	PAPER NUMBER
			2835	

DATE MAILED: 10/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H.P.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/679,821

Applicant(s)

UNNO ET AL.

Examiner

Anatoly Vortman

Art Unit

2835

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.



Anatoly Vortman
Primary Examiner
Art Unit: 2835

Continuation of 11. does NOT place the application in condition for allowance because:

The Applicant's arguments are not persuasive.

The Applicant has presented arguments regarding the 35 USC 112, first paragraph rejection of claim 6, which is, allegedly, in error, since paragraph 8 of the specification teaches that bimetallic member is not a part of the main circuit.

Further, the Applicant contends that the bimetallic member is "loosely" or "freely" positioned in the window of the member (52) (Fig. 17), hence said bimetallic member, allegedly, is not in contact with the arm (151).

On the contrary, the Examiner believes that even "loosely" or "freely" positioned bimetallic member must abut on either the arm (151) or member (152) in order to operate (as clearly shown on the Fig. 17), thus forming parallel electrical connection with the arm (152).

The specification is silent about the measures, which would make said bimetallic member not a part of the main circuit, e.g. insulation means, isolative layer, etc. The specification contains only conclusionary statements, i.e. that said bimetallic member is not a part of the main circuit. Hence, the specification contradicts to the statute as recited in 35 USC 112, first paragraph, i.e. "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same...".

Artisan in the relevant art, while using the specification of the present application as a guidance, would not be able "to make and use" the invention as claimed, since specification does not explain how to electrically isolate the bimetallic member from the main circuit. Again, the conclusionary statements do not provide adequate explanation, especially in light of the drawings, which show the opposite, i.e. that said bimetallic member is in contact with the main circuit.

Further, as shown on figures (for example Fig. 1, 2, 13, and 15-17), the bimetallic member is clearly connected electrically in parallel with the contact carrying arm and, therefore, will split the current equally. Thus, said bimetallic member is a part of the main circuit.

The Applicant's statement that "drawings of the structure are used to diagrammatically show the structure of the invention" is not persuasive, since, as stated above, in the structure depicted on the figures (for example Fig. 1, 2, 13, and 15-17), the bimetallic member must contact the main circuit, because if it is not in contact, the invention would not work.

Even if the assumption is made that at some point said bimetallic member is not in contact with the main circuit (i.e. with movable plate), this imaginary condition would be temporary and unstable. Indeed, any change in temperature would bend or creep said bimetallic element, thus placing it in contact with the window of the upstanding part or with the upstanding part itself. Also, during initial phases of any disconnection operation (while contacts are still connected), said bimetallic member would be bent or undergo a creeping action, thus contacting the main circuit.

In view of the above, the Examiner believes that 35 USC 112, first paragraph rejection of claim 6 is proper.

Further, regarding the art rejection, the Applicant contends that movable plate of Ubukata et al., allegedly, is not connected to the housing because Ubukata et al. "at best shows movable plate 17 connected to header 1".

Firstly, the Examiner would like to direct the Applicant's attention to the fact that said movable plate (17) of Ubukata is connected to the housing via said header, and secondly, independent claim 6 only recites: "an electrically conductive stationary member that secures the movable plate and the thermally responsive member to the housing". The movable plate (17) of Ubukata is clearly "secured" to the housing as shown on Fig. 9. The claim is broader than argued.

Further, contrary to the Applicant's position, the plate (17) of Ubukata is movable, since it would inherently moves along with thermally responsive member (16).

In view of the above all rejections of record are believed to be proper and maintained herein.

 **ANATOLY VORTMAN
PRIMARY EXAMINER**